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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,846	12/22/2000	Richard P. Modelski	P 270184 NOR-13176BA	8545

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EXAMINER	
THAI, XUAN MARIAN	
ART UNIT	**PAPER NUMBER**
2111	16

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/741,846	MODELSKI ET AL.	
	Examiner	Art Unit	
	XUAN M. THAI	2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-16 and 18* is/are rejected.

7)☒ Claim(s) *9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Request for Continue Examination filed on April 5, 2004.

2. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 9 are the same as the last two limitations of claim 6. Therefore, claim 9 does not further limit claim 6.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 5-8, 10-16 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-16 of U.S. Patent No. **6,665,755**. Although the conflicting claims are not identical, they are not patentably distinct

from each other because claims 4-16 of patent # 6,665,755 contains every element of claims 5-8, 10-16 and 18 of the instant application and as such anticipates claims 5-8, 10-16 and 18 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

5. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 7 and 8 of U.S. Patent No. **6,665,755** in view of Jones et al. (USPN 6,693,914; Jones). Claims 4, 7 and 8 of patent no. 6,665,755 discloses all the claimed limitations of claims 1-3 of the instant application, except for an arbiter. At the time the invention was made, it is known to one of ordinary skill in the art, as exemplify by Jones that arbitration for a common resource (bus) is known, see e.g. fig. 3, element 22, col. 5, lines 22-40. It would have been obvious to one of ordinary skill in the art to modify the system of patent no. 6,665,755 to include an arbiter as taught by Jones such as the combination of patent no. 6,665,755 and Jones would result in a more efficient system to provide a mean for system devices to obtain common resources (col. 1, lines 20-42).

6. Claims 5-8, 10-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-19 of copending

Application No. **09/742,288**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-19 of copending Application No. 09/742,288 contains every element of claims 5-8, 10-16 and 18 of the instant application and as such anticipates claims 5-8, 10-16 and 18 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 7, 10 and 12 of copending Application No. **09/742,288** in view of Jones et al. (USPN 6,693,914; Jones). Claims 5, 7, 10 and 12 of copending Application No. 09/742,288 discloses all the claimed limitations of claims 1-4 of the instant application, except for an arbiter. At the time the invention was made, it is known to one of ordinary skill in the art, as exemplify by Jones that arbitration for a common resource (bus) is known, see e.g. fig. 3, element 22, col. 5, lines 22-40. It would have been obvious to one of ordinary skill in the art to modify the system of Application No. 09/742,288 to include an arbiter as taught by Jones such as the combination of Application No. 09/742,288 and Jones would result in a more efficient system to provide a mean for system devices to obtain common resources (col. 1, lines 20-42).

This is a provisional obviousness-type double patenting rejection.

8. Claims 5-8, 10-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-18 of copending Application No. **09/741,845**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5-18 of copending Application No. 09/741,845 contains every element of claims 5-8, 10-16 and 18 of the instant application and as such anticipates claims 5-8, 10-16 and 18 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 and 9 of copending Application No. **09/741,845** in view of Jones et al. (USPN 6,693,914; Jones). Claims 2-4 and 9 of copending Application No. 09/741,845 discloses all the claimed limitations of claims 1-4 of the instant application, except for an arbiter. At the time the invention was made, it is known to one of ordinary skill in the art, as exemplify by Jones that arbitration for a common resource (bus) is known, see e.g. fig. 3, element 22, col. 5, lines 22-40. It would have been obvious to one of ordinary skill in the art to modify the system of Application No. 09/741,845 to include an arbiter as taught by Jones such as the combination of Application No. 09/741,845 and Jones would result in a more efficient system to provide a mean for system devices to obtain common resources (col. 1, lines 20-42).

This is a provisional obviousness-type double patenting rejection.

10. Claims 5-8, 10-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-18 of copending Application No. **09/741,857**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5-18 of copending Application No. 09/741,857 contains every element of claims 5-8, 10-16 and 18 of the instant application and as such anticipates claims 5-8, 10-16 and 18 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 and 9 of copending Application No. **09/741,857** in view of Jones et al. (USPN 6,693,914; Jones). Claims 2-4 and 9 of copending Application No. 09/741,857 discloses all the claimed limitations of claims 1-4 of the instant application, except for an arbiter. At the time the invention was made, it is known to one of ordinary skill in the art, as exemplify by Jones that arbitration for a common resource (bus) is known, see e.g. fig. 3, element 22, col. 5, lines 22-40. It would have been obvious to one of ordinary skill in the art to modify the system of Application No. 09/741,857 to include an arbiter as taught by Jones such as the combination of Application No. 09/741,857 and Jones would result in a more efficient system to provide a mean for system devices to obtain common resources (col. 1, lines 20-42).

This is a provisional obviousness-type double patenting rejection.

12. Claims 5-8, 10-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-18 of copending Application No. **09/741,999**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5-18 of copending Application No. 09/741,999 contains every element of claims 5-8, 10-16 and 18 of the instant application and as such anticipates claims 5-8, 10-16 and 18 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 and 9 of copending Application No. **09/741,999** in view of Jones et al. (USPN 6,693,914; Jones). Claims 2-4 and 9 of copending Application No. 09/741,999 discloses all the claimed limitations of claims 1-4 of the instant application, except for an arbiter. At the time the invention was made, it is known to one of ordinary skill in the art, as exemplify by Jones that arbitration for a common resource (bus) is known, see e.g. fig. 3, element 22, col. 5, lines 22-40. It would have been obvious to one of ordinary skill in the art to modify the system of Application No. 09/741,999 to include an arbiter as taught by Jones such as the combination of Application No. 09/741,999 and Jones would result in a more efficient system to provide a mean for system devices to obtain common resources (col. 1, lines 20-42).

This is a provisional obviousness-type double patenting rejection.

14. Claims 1-8, 10-16 and 18 would be allowed if all double patenting issues are resolves and the following is a statement of reasons for the indication of allowable subject matter: the claimed method and apparatus comprising a master request bus and a slave request bus in a global access bus; wherein the master bus and slave request bus utilize a protocol enabling transfer of data between computer hardware operating according to different protocols; and an analysis machine for classifying packet data.

Prior art of record such as Tagged teaches a master request bus and slave request bus however, prior art of record do not make obvious the claimed combination above.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to XUAN M. THAI whose telephone number is 703-308-2064. The examiner can normally be reached on Monday to Friday from 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

XUAN M. THAI
Primary Examiner
Art Unit 2111

XMT
May 3, 2004